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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Kiyotaka ISHINO et al.

Examiner: R. Sergent

Serial No.: 09/423,523

Group Art Unit: 1711

Filed: July 5, 2000

Title: FILM FOR ACCELERATED COMPOST FERMENTATION

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Claims 4 - 9 and 12 - 15, all claims pending, remain rejected under 35 U.S.C §103 over Fleischer '024 or Werenicz '887 or WO '174, each taken with Tesch '327. These claims all recite methods of composting. Each primary reference discloses a water vapor permeable film, used in an area distinct from composting, such as roofing materials or automotive parts. See the discussion at page 3 of the Brief on Appeal. Indeed, the final rejection admits that the "primary" references fail to suggest the use of their films in the production of covers for composting. However, the Final Rejection relies upon Tesch, for its teaching of composting, arguing that it would be obvious to use the primary references' films in Tesch's utility.

Tesch teaches two different types of compost covers. The first compost cover taught in Tesch is a polymer sheet, which, where "gas permeability" is desired, may be slit by cutting. See column 4, lines 58 - 62 of the reference. Patentees teach that such slitting of the polymeric sheet provides " a fairly precise amount of *air* permeability (emphasis added), by a "precisely controlled slitting operation." (Emphasis added). See column 3, the last paragraph. Patentees

also teach an additional type of sheet, a fibrous woven sheet, in which air permeability is provided by control of the degree of compression during fabrication. See the above-noted text.

Thus, by teaching the use of slitting, patentees teach a method of increasing gas permeability which also, necessarily, increases liquid permeability inasmuch as liquid could easily enter the slits in the sheet. While patentees teach compensation for the amount of light admitted through the slits, see column 4, lines 62 - 65, patentees do *not* teach compensation being necessary for additional liquid water being admitted. Indeed, patentees teach that the slitting "ensures a permeability to rain and/or irrigation water, see column 5, lines 49 - 50. Patentees appear to teach that such permeability is "desirable". See column 5, lines 55 - end, where patentees indicated to be desirable to allow water to "gradually drip through the web."

Despite this, it is argued in the paragraph bridging pages 3 and 4 of the Examiner's Answer, that the reference emphasizes gas exchange, and that one of ordinary skill in the art would be motivated to use the gas permeable films taught by the primary references, as one of ordinary skill in the art would "appreciate the advances in gas permeable films." Regardless of whether one of ordinary skill in the art might appreciate such advances, one of ordinary skill in the art would also clearly appreciate that the only reference of record directed to the method presently claimed, composting, teaches the necessity of allowing liquid water to "drip through" the film. Thus, one of ordinary skill in the art would simply *not* have been motivated to employ the films of the remaining references, which, according to the Answer, are impermeable to liquid. It is noted that, the present claims recite films which are impermeable to liquid water but water vapor permeable; it is not why such recitation is "ambiguous."

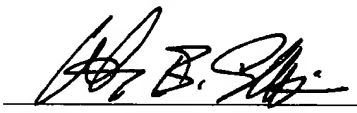
It is argued at page 4 of the Answer that since the films of the "primary" references "also possess the characteristic of being impermeable to liquid water", it is not seen "that this limitation distinguishes the instant claims from the prior art." Such an argument is circular logic. These references are not directed to composting utilities. The only reference of record directed to composting teaches the necessity for the film to be permeable to liquid. The fact that other films exist which are impermeable to liquid, which films are not taught for use in composting utility, does not provide motivation for one of ordinary skill in the art to make such a substitution.

Finally, it is argued at page 4 of the Office Action that the primary and secondary references are directed to analogous art, inasmuch as they are "concerned with the utilization of polymeric materials having gas exchange properties that are suitable for protection from the elements." This is the same broad-brush analysis which was criticized in *In re Clay*, cited in Appellant's Brief. In *Clay*, the court held that injecting foam into a subterranean reservoir to flush out oil was *not* analogous to injecting foam into an oil tank to flush out oil, inasmuch as in the different environments of the references different performance consideration were encountered. In the present situation, the same is true: roofing materials, sufficient to increase leak proofing, without retaining moisture (see column 3, lines 20 - 60 of Fleisher '024) clearly impose different considerations than that of composting, in which the passage of liquid, as taught by Tesch, is desirable.

Accordingly, it is maintained that ample basis to overturn the rejections of record exists, and the same is respectfully requested.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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